

REMARKS

Claims 1-14 are presented without further amendment in the light of the following remarks and authorities. Applicant provisionally elects to prosecute the invention of Group 1, and the species of Agarose-Poly (ethylene glycol) beads, claims 1, 2, 9 and 10 should the requirement for restriction be made final.

The requirement for restriction is respectfully traversed.

35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. headed 802.01, "Meaning of 'Independent', 'Distinct' reads as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT.

M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to Group 1 must be searched in connection with examining the claims in the other groups, and all the claims have already been searched and examined.

The Court of Customs and Patent Appeals has also recognized that "independent and distinct" means "independent and distinct." *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100 Deputy Director John Doyle said:

Restriction was required between (I)method for epitaxial deposition and (II)epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all

pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions".

The Petition is GRANTED.

That the inventions are related precludes a ruling that the groups are independent and distinct, for each group is related to Group I.

Manifestly, search and examination of the entire application can be made without serious burden because all the claims are dependent upon elected claim 1 and prior art related to claim 1 is likely to disclose subject matter which must be searched in connection with examining claims in each of the relating groups. That search and examination of the entire application can be made without serious burden is proved beyond a reasonable doubt because in fact all fourteen claims were searched and examined in this application, and the requirement for restriction was not made until after applicant filed its Notice of Appeal and Appeal Brief. Accordingly, it is respectfully requested that the requirement for restriction be withdrawn. If the requirement for restriction is repeated, the Examiner is respectfully requested to rule that the claims in each group are PATENTABLE (novel and unobvious) OVER EACH OTHER and explain why all the claims cannot be examined without serious burden.

The office action states:

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (USPN 4,229,547) and Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable Jederström et al. (USPN 4,997,867).

In the abstract and col. 6, lines 49-54, Cohen et al. teach dry polymer bead particles comprising highly water-soluble diluents such as polyoxyethylene alcohols.

In col. 1, lines 19-26, col. 2, lines 48-68 and col. 3, lines 26-42, Jederström et al. teach dry polysaccharide bead particles, such as cross-linked agarose comprising highly water-soluble diluents such as polyoxyethylene glycol.

While Cohen et al. or Jederström et al. may not expressly teach the disclosed "rapid swelling" properties of the claimed polymer beads, it is reasonable that the dry polymer beads Cohen et al. or Jederström et al. would possess the presently claimed properties since the composition of Cohen et al. or Jederström et al. is essentially the same as the claim composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In *re* Fitzgerald et al., 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-§ 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art. PP. 5-6.

These grounds of rejection are respectfully traversed. We rely on the authorities on pages 5-6 of the Appeal Brief. For the Section 103 rejection we rely on at least the following authorities.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In *re* Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [Dembiczak]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

The final action relied on seven patents, all of which we distinguished in the Appeal Brief. Of these seven patents, only Cohen Patent No. 4, 229, 547 is being applied, and we distinguished this reference in the last full paragraph of page 6 of the Appeal Brief and the paragraph spanning pages 6 and 7. In addition, the office action relies on newly cited Jederström Patent No. 4, 997,867. The office action recognized that neither reference discloses a polymer bead of dry bead structure incorporating a diluent that is highly water-soluble characterized by swelling rapidly when placed in contact with aqueous media to form a water-swollen gel bead. Nor does either reference suggest the desirability of modifying what is there disclosed to meet the limitations in the rejected claims.

Cohen, discloses a process for producing uniform spherical polymer beads having excellent porosity and unusually high bulk density that are clearly different in properties of the claimed beads.

Jederström discloses forming a uniform dispersion of particles dispersed in an aqueous matrix to which a softening agent may also be added and fails to disclose any process or processes by which particle formation occurs. The particles specifically cited arekstranckstrand or natural starch, or by the production in bead form of chemically cross-linked polyacrylamide polymers by vinyl polymerization of acrylamide monomers and failed to disclose polymer beads of dry bead structure incorporating a diluent that is highly water soluble characterized by swelling rapidly when placed in contact with aqueous media to form a water-swollen gel bead.

If these grounds of rejection are repeated, the Examiner is respectfully requested to quote verbatim the language in the references corresponding to each limitation in the rejected claims, and quote verbatim the language in each reference regarded as suggesting the desirability of modifying what is there disclosed to meet the limitations of each rejected claim.

The reliance on *In re Fitzgerald*, 205 U.S.P.Q. 594 (C.C.P.A. 1980) is inapposite that case only held that the fastener in the rejected claims was only slightly different from the fastener in

the reference in sustaining the section 103 rejection. Here the claimed invention is significantly different from what is disclosed in the prior art patents.

In view of the foregoing authorities, remarks and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps he believes are necessary to place the application in a condition for allowance.

Please apply any charges or credits to deposit account 06-1050.

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Date: _____

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